

ZTW  
AF

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission 20

Application Number	09/705,559
Filing Date	11/02/2000
First Named Inventor	Joseph A. McCluskey
Art Unit	3624
Examiner Name	Kyle, Charles R.
Attorney Docket Number	31083.04US1

### ENCLOSURES (Check all that apply)

- |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                            |                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                                 |                                                                                                                                                                                                                                                                                                                                                                                                                                            |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Reply to Missing Parts/ Incomplete Application<br><input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) _____<br><input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC<br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

Remarks

- return postcard

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Customer No. 34018 - Greenberg Traurig, LLP		
Signature			
Printed name	Gary R. Jarosik		
Date	September 9, 2005	Reg. No.	36,805

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Ranni Matar	Date	September 9, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: McCluskey et al. )  
Serial No. 09/705,559 ) Examiner: Kyle, Charles R.  
Filed: November 2, 2000 ) Art Unit: 3624  
Title: System And Method For ) Attny Docket: 31083.04US1  
Electronically Sourcing )  
Products )

SUBSTITUTE APPEAL BRIEF

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby submit this substitute Appeal Brief to the Board of Patent Appeals and Interferences to respond to the Examiner's final rejection of claims 1-16 which rejection was set forth in an Office Action mailed June 1, 2004.

This Appeal Brief is being filed in triplicate.

It is not believed that any further fees are required.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9<sup>th</sup> day of September, 2005.

By: Ranni Matar  
Ranni Matar

I. Real Party In Interest

The real party in interest is W.W. Grainger, Inc.

II. Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status Of Claims

In the application, claims 1-16 remain pending and, having been finally rejected, are the subject of this appeal.

Appendix I provides a clean, double spaced copy of pending claims 1-16.

IV. Status Of Amendments

The claims are in condition for appeal – no further amendments to the claims are pending.

V. Summary Of Claimed Subject Matter

The invention set forth in rejected claims 1-16 is directed to a system and method for providing product information to an on-line user. More particularly, the claimed system and method automates the finding of a source for a product that is specified in a search request but is not presently included within an electronic catalog. The claimed system and method not only automates the finding of a sourcing agent for a specified product but also returns to the user information about the product when found by the sourcing agent. Still further, the claimed system and method functions to update the electronic catalog using the information that is returned to the user.

In keeping with the claimed invention, to request the product information, a user may be presented with a Web page or the like that allows a user to initiate an electronic search for a product within an electronic catalog. Generally, a request for product information includes one or more product identifiers. In the event that the electronic catalog has listed therein any products that correspond to the product identifier(s) entered by the user the product information for the matching product(s) is extracted from the electronic catalog and returned to the user by the system. (See Fig. 2; Page 6, lines 15-25). If, however, the system determines that the electronic catalog does not contain information for the requested product(s), the system compares information within the request against a set of predetermined rules to determine a sourcing agent to which the electronic request is to be routed and the system then functions to automatically route the request to that sourcing agent. In this manner, the claimed system and method has the advantage of automatically ensuring that the request is routed to a sourcing agent that specializes in finding sources for the product type specified by the user. (See Fig. 2; Page 8, lines 13-20). Product information retrieved by the sourcing agent is then transparently returned to the user so that it appears to the user as if the requested product(s) were in the electronic catalog all along. The product information may also be manually or automatically entered into the electronic catalog to thereby keep current the electronic catalog. (See Fig. 2; Page 9, lines 6-16).

#### VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether the rejection of claims 1-16 under 35 U.S.C. § 103 can be maintained when the references being relied upon, whether considered alone or in combination, fail to disclose each and every element, considering each and every word, set forth in the claims.

2. Whether the rejection of claims 1-16 under 35 U.S.C. § 103 can be maintained when the proposed modification of the primary reference would change the principle of operation of the primary reference.

## VII. Argument

Pending claims 1-16 presently stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Talib (U.S. Patent No. 2001/004758) as modified by Liddy (U.S. Patent No. 6,304,864). In rejecting the claims, the Office Action set forth that Talib discloses “the invention substantially as claimed” including receiving an electronic request for information for the product (citing to Para. 19, lines 4-5); searching a database to determine if the database contains information for the product (citing to Para. 19, lines 5-10); if the database contains information for the product, sending an electronic message to the customer containing selected information for the database corresponding to the product (citing to Para. 19, lines 10-15); if information is not found for the product, performing a subsequent search to gather information for the product (citing to Figs. 10 and 11; Para. 120-146), sending the gathered information in an electronic message to the customer (citing to Para. 19), and adding gathered information to the database (citing to Para. 6). While the Office Action acknowledged that Talib fails to disclose, teach, or suggest, among other things, a sourcing agent performing a search, the Office Action nevertheless asserted that such was disclosed in Liddy (citing to Col. 9, line 49-Col. 11, line 57). Thus, the Office Action concluded that it would have been obvious to broaden the product search disclosed by Talib by searching additional databases as disclosed by Liddy because “this would have given a greater search area and increased the likelihood that the customer would receive relevant information from subsequent searches.”

In response to the rejection of the claims, it is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103 requires that the combination of prior art references disclose each and every element set forth in the claims, *considering each and every word*. This requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, *with no knowledge of the claimed invention*, would have selected the various parts from the references and combined them in the claimed manner.

It is further respectfully submitted that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Similarly, a statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *See In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). Yet further, a proposed combination of the prior art that would have all of the claim elements fails to have the requisite teachings or suggestions when the proposed combination would change the principle of operation of the prior

art invention being modified. In such a case the teachings of the references are not sufficient to render the claims *prima facie* obvious. See In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

A) Talib and/or Liddy Fail To Disclose Each And Every Element Claimed

Talib fails to “disclose the invention substantially as claimed” as has been espoused in the Office Action. Talib is directed to a system for searching an electronic catalog that solves, among others, the problem of user frustration associated with a user searching for a product that does not exist within the product database (See Para. 29, lines 1-4). To solve this problem, Talib only allows a user to search for products that are already within the product database and which have been tagged with various taxonomy labels. In this manner, when a user enters a search query, the system of Talib presents to the user taxonomy categories relevant to the search term and the user may then select from only those presented taxonomy categories to further refine their search. By “pushing data back to the user,” the system of Talib never presents invalid, zero-member categories and, therefore, is designed specifically and expressly to prevent a user from specifying a product that does not exist within the electronic catalog taxonomy. (See Figs. 10 and 11; and Paras. 120-146).

When Talib is considered in its entirety, it is evident that, by preventing a user from “defining a product that does not exist” within the electronic catalog, the system of Talib, *by its express design*, will always return to a customer information for a product that already exists within the electronic catalog when a search is performed. Since product information for products that already exist within the electronic catalog is always returned when a search is performed using the system of Talib, *an instance never arises in Talib where the electronic database fails to contain information for the product being requested*. Thus, contrary to the position taken in the

Office Action, the system of Talib can never determine that “the electronic database does not contain information for a product,” and, as such, the system of Talib never “performs a search outside of the electronic database to gather information for the product [requested but not in the database] which gathered information is returned to the customer in an electronic message and added to the electronic database” and certainly never uses product descriptors to determine “if a product does not exist” in the catalog (since the product always exists in the catalog of Talib) let alone “to determine a sourcing agent to which an electronic request is to be routed in the event that the electronic database does not contain information for a product” (claims 6-10). It is at least these claim elements that are missing from Talib.

From the foregoing, it is submitted that Talib never discloses any instance where information for a product is not already found in the electronic catalog, *as is set forth in the claims*, any instance where product descriptors are used to determine if a product cannot be found within an electronic catalog, *as is set forth in the claims*, any instance where an electronic request is compared against a set of predetermined rules to determine a sourcing agent to which an electronic request is to be routed, *as is set forth in certain of the claims*, any instance where a search is performed outside of the electronic catalog to gather information for a product determined not to be found in the electronic catalog, *as is set forth in the claims*, or any instance where information gathered outside of the electronic catalog is then added to the electronic catalog, *as is set forth in the claims*. Rather, as discussed above, the system of Talib is expressly designed to prevent a user from searching for a product not already within the Talib electronic catalog (which type of search would be a prerequisite to the aforementioned claim steps being performed). Therefore, since Talib fails to disclose those elements being relied upon in the



obviousness rejection set forth in the Office Action, the rejection of the claims under 35 U.S.C. § 103 must be withdrawn.

While it has been previously asserted that the “Appellants fail to recognize that the closed system of Talib...is but one embodiment,” the Appellants respectfully submit that Talib describes no embodiments that might be said to include the elements of the claims that have been acknowledged to be missing from the “closed system” disclosed by Talib. In this regard, while Talib describes in the Background that traditional “open ended” search methods existed that may return null search results (*See* Para. 29 of Talib) and that general Internet searching existed (*See* Paras. 071-081 of Talib), Talib does not disclose or suggest that these prior, known systems included the claimed “if the electronic database does not contain information for the product, automatically sending an electronic request to perform a search outside of the electronic database to gather information for the product” or the claimed “returning the gathered information to the customer in an electronic message and adding the gathered information to the electronic database.” Therefore, since the preferred embodiment of Talib, which has been acknowledged to be directed to a “closed system,” i.e., one in which all searches (initial and subsequent) are performed using taxonomy labels which have been provided to products already in an electronic catalog, and any other system described in Talib, such as the “open ended” systems described in the Background of Talib, fail to disclose at least the aforementioned claim elements, there is no manner in which Talib can be read as disclosing “the invention substantially as claimed” as was set forth in the rejection of the claims. Accordingly, the combination of Talib and Liddy cannot be said to include each and every element of the claims as is required to maintain a rejection under 35 U.S.C. § 103.

Considering now Liddy, Liddy discloses a Web crawling system for retrieving documents from vast numbers of data repositories spread over the Internet. To this end, a user enters a search query and based upon a user profile an agent server generates meta-search agents which are sent to general purpose search engines and specialized search engines across the Internet to retrieve generally uncategorized documents. (Col. 6, lines 26-31; Col. 9, lines 66-Col. 10, line 10). Thus, Liddy describes nothing more than the exact type of searching methodology that the system of Talib expressly describes in the Background section as one to avoid, namely, a search methodology which navigates vast numbers of electronically stored records that are not categorized as stored.

While Liddy may teach the desirability of providing a “greater search area,” as has been asserted in the rejection of the claims, nothing from Liddy can be said to disclose, teach, or suggest the desirability of modifying Talib to include those claim elements which are clearly missing from Talib, namely, the expressly claimed determining (by comparing the electronic request against a set of predetermined rules) a sourcing agent to which an electronic request is to be routed in the event that a product catalog fails to have a product of interest to a user. Since it is required that Liddy suggest more than the desirability of providing a “greater search area,” i.e., it is required that Liddy suggest modifying Talib to include all of those claim elements that are missing from Talib, the disclosure within Liddy, which omits the requisite elements and, therefore, any suggestion to include those elements in Talib, fails to be sufficient to support a *prima facie* case of obviousness. Therefore, for the reason that Liddy fails to mention sourcing agents, product catalogs, or the like, it is submitted that the only conclusion that can be drawn is that the Office Action has utilized the Appellant’s disclosure to infer these missing elements into

Liddy. Since using the Appellant's disclosure in this manner is impermissible, it is respectfully submitted that, for this still further reason, the rejection of the claims must be withdrawn.

**B) The Proposed Modification Changes The Principle Of Operation Of Talib**

When the teachings of Talib and Liddy are fully and fairly considered in their entirety, it will be appreciated that a modification of Talib to incorporate the Web crawlers of Liddy would impermissibly change the principle of operation of Talib, i.e., it would allow for searching beyond the stringent taxonomy provided to the Talib catalog. In this regard, it has been acknowledged that the system of Talib is directed to a "closed system," i.e., a system in which all searching is limited to a stringent taxonomy which is utilized to categorize all possible search results. To achieve this goal, the principle of Talib's system is to limit the searching abilities of a user by presenting to the user only taxonomies of products already within the electronic catalog. In this manner, the user is never frustrated by a request to find a product that does not already exist within the electronic catalog.

Meanwhile, the elements of Liddy which the Examiner proposes to use to modify Talib to provide a "greater search area" are Web crawlers which are designed to retrieve uncategorized documents. Since this espoused modification would change the principle of operation of Talib from a "closed system" to an "open system" that would encompass searching outside of the stringent taxonomy required by Talib, the espoused modification is not sufficient to render the claims *prima facie* obvious and the rejection of the claims must be withdrawn. As the express language of Talib itself serves to evidence that modifying Talib to include the Web crawling search methodology of Liddy to navigate vast numbers of uncategorized, electronically stored records is not desirable, i.e., it would change the very principle of operation of Talib, the

references are not sufficient to render the claims *prima facie* obvious and the rejection of the claims must be withdrawn.

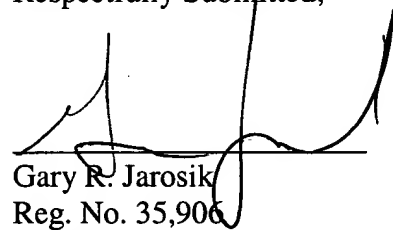
C) Conclusion

It is respectfully submitted that, when the claims are considered *as a whole*, the claims are not rendered obvious by the combination of references set forth in the Office Action. As such, it is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: September 9, 2005

By:



Gary R. Jarosik  
Reg. No. 35,906  
Greenberg Traurig, LLP  
77 W. Wacker Drive, Suite 2500  
Chicago, Illinois 60601  
(312) 456-8449

### VIII. Claims Appendix

The following is a copy of the claims involved in the appeal:

1. A method of providing a customer with information regarding a product, the method comprising:

receiving an electronic request for information for a product;

searching an electronic database to determine if the electronic database contains information for the product;

if the electronic database contains information for the product, sending an electronic message to the customer containing selected information from the electronic database that corresponds to the product; and

if the electronic database does not contain information for the product, automatically sending an electronic request to a sourcing agent to perform a search outside of the electronic database to gather information for the product which gathered information is returned to the customer in an electronic message and added to the electronic database.

2. The method as recited in claim 1, wherein requesting a sourcing agent to perform a search comprises forwarding the electronic request to the sourcing agent as a request for quotation.

3. The method as recited in claim 2, wherein the request for quotation is prepared by the customer in response to a prompt that is automatically sent to the customer when the electronic database does not contain information for the product.

4. The method as recited in claim 1, wherein the electronic request is received via the Internet.

5. The method as recited in claim 1, wherein the electronic request is forwarded to the sourcing agent via an email.

6. The method as recited in claim 1, comprising comparing the electronic request against a set of predetermined rules to determine the sourcing agent to which the electronic request is to be routed; and automatically routing the electronic request to the sourcing agent determined to be appropriate by the step of comparing, the sourcing agent performing a search to find a source for the product specified in the electronic request.

7. The method as recited in claim 6, wherein the step of comparing comprises comparing words in the electronic request against a set of predetermined product descriptors to determine a type of product specified in the request.

8. The method as recited in claim 6, further comprising the step of preparing an email that includes information representative of the electronic request.

9. A computer-readable medium having instruction for sourcing a product, the instructions performing steps comprising:

receiving an electronic request specifying a product;

searching an electronic database to determine if the electronic database contains information for the product;

if the electronic database contains information for the product, sending an electronic message to a message recipient containing selected information from the electronic database that corresponds to the product; and

if the electronic database does not contain information for the product, automatically comparing the electronic request against a set of predetermined rules to determine a sourcing agent to which the electronic request is to be routed; routing the electronic request to the sourcing agent determined to be appropriate by the step of comparing where the sourcing agent performs a search outside of the electronic database to find a source for the product specified in the request; receiving an electronic message from the sourcing agent including information for the product from the source; and automatically updating the electronic database with the information for the product from the source.

10. The computer-readable medium as recited in claim 9, wherein the instructions perform the further step of sending the source for the product specified in the request as determined by the sourcing agent to an originator of the request.

11. A method of providing a customer with information regarding a product, the method comprising:

receiving an electronic request for information for a product;

searching an electronic database to determine if the electronic database contains information for the product;

if the electronic database contains information for the product, sending an electronic message to the customer containing selected information from the electronic database corresponding to the product; and

if the electronic database does not contain information for the product, performing a search outside of the electronic database to gather information for the product, sending the gathered information in an electronic message to the customer, and adding the gathered information to the electronic database.

12. A method of providing a customer with information regarding a product, the method comprising:

receiving an electronic request for information for a product;

searching an electronic database to determine if the database contains information for the product;

if the electronic database contains information for the product, sending an electronic message to the customer containing selected information from the electronic database corresponding to the specified product; and

if the electronic database does not contain information for the product, providing the customer with an option to authorize a further search outside of the electronic database to gather information for the product which, if authorized, causes the performing of the further search, the returning to the customer in an electronic message the gathered information, and the adding of the gathered information to the electronic database.



13. An electronic commerce system, comprising:

an electronic catalog having product information;

a first component that accepts an electronic request for quotation for a product not contained within the electronic catalog, the first component automatically routing the request for quotation to a sourcing agent determined by the first component to be appropriate for finding a source for the product not contained within the electronic catalog; and

a second component that allows a user to search the electronic catalog to gather information for a selected product and that automatically provides access to the first component if the electronic catalog does not contain information pertaining to the selected product.

14. The system as recited in claim 13, wherein the electronic catalog and second component reside on a Web server of a third party vendor.

15. The system as recited in claim 13, further comprising a portal through which the electronic catalog, first component and second component are accessible.

16. The system as recited in claim 13, wherein the electronic catalog, first component and second component reside on a single Web server.

IX. Evidence Appendix

No evidence has been submitted pursuant to Secs. 1.130, 1.131, or 1.132 and no additional evidence is being relied upon in this appeal.

X. Related Proceedings Appendix

No decisions rendered by a court or the Board related to this appeal exist for submission.